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EXAMINER

JUNG, DAVID YIUK

ART UNIT

PAPER NUMBER

2434

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/897,013	Applicant(s) PELED ET AL.	
	Examiner David Y. Jung	Art Unit 2434	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11/15/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,5,6,10,14,19,22,24 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,5,6,10,14,19,22,24 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

CLAIMS PRESENTED

Claims 1, 5, 6, 10, 14, 19, 22, 24, and 35 are presented.

Response to Arguments

Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant's arguments regarding the prior art are thus: (1) despite Brown reference specifically noting the use of Copyright Agent and Media Tracker, Applicant still insists that the content of Brown reference can be dated to be no earlier than the publish date of the Brown reference (2) despite the very important teaching of Brown (at the second paragraph) that tracking programs track "what" is being downloaded, Applicant still insists that the Brown reference does not teach searching for "predetermined material" (3) despite Brown reference teaching peer-to-peer network and even going so far as to actually teach the exact software being used for peer-to-peer network (GNUTELLA, NAPSTER, etc.), Applicant still insists that Brown reference does not teach "elements distributed nodewise on a network."

Of these three arguments, the first argument (date of reference) may be most credible. Thus, the other two arguments shall be addressed earliest.

As for "predetermined material", this is clearly "what" being downloaded. Is Applicant truly saying otherwise? Surely not. Applicant would not wish a patent

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allowance on basis of factual error (that of “predetermined material” not being the “what” being downloaded).

As for “elements distributed nodwise on a network”, is Applicant willing to state that GNUTELLA and NAPSTER (as mentioned in the Brown article), do not teach this? Surely not. Again, Applicant would not wish a patent allowance on basis of factual error (of GNUTELLA and NAPSTER not being such a network).

Nevertheless, the Brown reference may somehow be less than completely persuasive to those who wish to believe that the Brown reference (despite mention of MediaTracker and CopyrightAgent) do not teach such use of software in 2000 and before (although one may reasonably question how MediaTracker and CopyrightAgent were so famous in year 2000).

Thus, an alternative rejection is presented. A Wired article by Jeffrey Howe surveys the history of one surveillance company: BigChampaign. This article (published in 2003) mentions that BigChampaign already had software capable of recording and archiving the contents list of shared folders and 50 million search queries a day as of summer of year 2000.

As for issues regarding 35 USC 101, please see the rejections. The current Office Action has more details than the previous Office Action. In particular, please note the discussion on In re Bilski 88 USPQ 2d 1385 CAFC (2008). One must note that the standards used by the USPTO was not universally accepted (at least by the losing litigants against USPTO and possibly by others as well).

CLAIM REJECTIONS

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Regarding Claims 1, 5, 6, 10, 14, 19, 22, 24, and 35, the claimed invention is directed to non-statutory subject matter. Claims recite only perfunctory recitation of functional material (processor, etc.). Aside from this, the claims recite only nonfunctional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance.

USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all

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claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384, 217 USPQ at 403; see also Diehr, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

A 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876). An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

For further guidance on the term “nonfunctional”, please see MPEP 2106.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 5, 6, 10, 14, 19, 22, 24, and 35 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Howe (Wired article as mentioned and cited in the previous paragraphs.

1. (Currently Amended) A system for external monitoring of networked digital file sharing to track predetermined data content, (the 7th from the last paragraph, in which the software in summer of year 2000 was monitoring 50 million search queries, to the point of becoming the Nielson of peepr-to-peer; the predetermined data content was being tracked so as to be able to judge the download use) the system comprising: a processor configured to provide: at least one surveillance element for distribution over said network, said elements comprising: search functionality for searching of said networked digital file sharing; identification functionality associated with said search functionality for identification of said predetermined data content at a given file sharing system, therewith to determine whether said given file sharing system is distributing said predetermined data content (the 7th from the last paragraph, in which the software in summer of year 2000 was monitoring 50 million search queries, to the point of

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becoming the Nielson of peer-to-peer; the distributing was being monitored because peer-to-peer sites were monitored), and an output, associated with said identification functionality, to produce an output indicative of said determining (the 7th from the last paragraph, in which the software in summer of year 2000 was monitoring 50 million search queries, to the point of becoming the Nielson of peer-to-peer; the BigChampaign company getting output for such data and selling its service).

5. A system according to claim 1, wherein said surveillance element is a first surveillance element and said search functionality comprises functionality for operating search features of said networked digital file sharing.

6. A system according to claim 5, wherein said identification functionality comprises use of a signature of said predetermined content.

10. A system according to claim 6, wherein said signature comprises a result of carrying out signal processing on data of said content.

Claims 5,6,7 recite various identification and search elements (such as by looking at signature elements). These are expected (immediately envisaged, or even inherent) parts of any very large search software. With 50 million searches already in year 2000, BigChampaign was already using a search software for very large data sets.

Claims 14, 19, 22, 24, 35 depend from claim 5, which ultimately depends from claim 1.

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14. A system according to claim 5, wherein said identification functionality comprises a signature of said predetermined content for comparison with data of said intercepted message to determine whether said message contains said evidence of said data content.

19. A system according to claim 14, wherein said signature comprises a title of the said data content.

22. A system according to claim 19, wherein said signature comprises a result of carrying out signal processing on data of said content.

24. A system according to claim 19, wherein said signature comprises a derivative of the description of said content.

35. A system according to claim 24, wherein said signature comprises a result of signal processing carried out on data of said content.

These claims 14, 19, 22, 24, 35 recite various signature handling. Such particular features are expected (immediately envisaged, or even inherent) of any very large search software. Signature handling is needed for having sufficient efficiency to handle very large data sets.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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As an alternative (and supplemental) rejection, Claims 1, 5, 6, 10, 14, 19, 22, 24, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (cited in an earlier Office Action).

Brown teaches as noted in the previous Office Action.

As Applicant noted, the new claims recite “processor” and no longer recite “nodes.” This is, of course, a broadening of claims in every way except for “processor.”

A processor is well known in the art for the motivation of executing software.

It would have been obvious to combine the teachings of Brown and the teachings from the ordinary level of art regarding processors. The combination of the two teachings would have been motivated by the motivation noted in the previous paragraph.

As for further details such as the discussion of other claims, see the previous Office Action. As Applicant himself noted, this amendment was done to address the 35 101 issues rather than narrow the scope of claims. Any intentional scope changes were done to broaden the claims.

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Points of Contact

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Any response to this action should be mailed to:

Commissioner for Patents

Alexandria, VA 22313.

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Kambiz Zand whose telephone number is (571) 272-3811.

/David Y Jung/

Acting Examiner of Art Unit 2434

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David Jung

David Jung

Patent Examiner

1/2/09